

REMARKS

The issues outstanding in the Office Action mailed December 6, 2005, are the claim rejections and the single rejection of all claims under 35 U.S.C §103. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

Claim Rejections

The Examiner is thanked for noting the lack of a period in claim 7 and appropriate typographical change has been made. In addition, the claim has been conformed to antecedent basis in the specification, e.g., figure 10. Withdrawal of the rejection is respectfully requested.

Rejection Under 35 U.S.C §103

Claims 1 - 7 have been rejected under 35 U.S.C §103 over Bultman '990 taken with Niwase (JP '345) and Nord. Reconsideration of this rejection is respectfully requested.

Bultman discloses a process electrowinning of copper obtained by solvent extraction; specifically, an improvement therein wherein electrowinning is conducted of the metal from an electrolyte containing a *fluoroaliphatic* surfactant, which surfactant inhibits mist-forming foam on the surface of the electrolyte. See, for example, column 3, lines 30 - 35. Patentees teach that the fluoroaliphatic surfactant has at least one cationogenic group which is a radical of a base, and containing about 30% by weight of fluorine in the form of carbon-bonded fluorine in a fluoroaliphatic radical, the fluoroaliphatic radical itself having at least four carbon atoms and at least a terminal perfluoro methyl group. See column 3, lines 35 - 42. All throughout patentees' disclosure, the improvement focused on *fluoroaliphatic* surfactants is taught. See, for example, column 4, lines 57 - 59, column 5, lines 9 - 12 and the formulae set forth at columns 7 - 9 of the patent. No other surfactants, other than fluoroaliphatic surfactants, are taught by patentees.

As acknowledged at page 2 of the Office Action, Bultman fails to teach the surfactant therein as a soluble surfactant which is an extract of the *Quillaja Saponaria* Molina tree. In order to remedy this deficiency, the Office Action cites Niwase, teaching that extracts from the *Quillaja Saponaria* Molina tree "had excellent surfactant properties." Regardless of the

existence of any such teaching in the secondary reference (relied upon in the Office Action), the conclusion drawn at the bottom of page 2, that it "therefore" would have been obvious to use the surfactant extract from *Quillaja Saponaria* Molina in the electrowinning process of the primary reference is contrary to established patent law.

In order to support a rejection under 35 U.S.C §103 based on obviousness, it is necessary that one of ordinary skill in the art has *motivation* to combine references. See, for example, *In re Laskowski*, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) among many others. *Laskowski* held that the mere fact that references *can* be combined, does not establish motivation, and thus the obviousness to do so, without some suggestion to one of ordinary skill in the art, either from the references themselves or from knowledge in the art, of a reason to make the combination. It is respectfully submitted that the mere fact that a surfactant has "excellent" surfactant properties does not render that surfactant, without more, obvious to use in the copper electrowinning process of the primary reference, unless one of ordinary skill in the art would find some reason to do so. In the present situation, such reason is absent on several bases.

First, *Quillaja Saponaria* Molina is *not* a fluorsurfactant. For example, attention is directed to Figure 10, setting forth the formula of one such component of the extract. It is well known in the art that *Quillaja Saponaria* Molina extract is not a fluorosurfactant, due to the triterpene chemical structure. It is clear from the teachings of the primary reference that not *any* surfactant is functional therein, but that patentees' improvement requires a fluorosurfactant. See, for example, the above-noted passages of the reference. Thus, regardless of any "excellent" surfactant properties known for *Quillaja Saponaria*, this alone is insufficient for one of ordinary skill in the art to find the motivation to employ such, a non-fluorosurfactant in the electrowinning process of the primary reference.

Moreover, the disclosure of the secondary reference is to a process utterly divorced from, and having nothing in common with, that of the primary reference. The secondary reference teaches that *Quillaja Saponaria* extract is useful in *shampoo*, and produces beneficial properties for hair. As such, it can be seen that the problem addressed by this reference is of no relation whatsoever to the process of the primary reference. Accordingly, one of ordinary skill in the art would have no expectation that the "excellent" surfactant properties of the material of the

secondary reference, said properties being relevant to shampoos, would translate in any manner whatsoever to the process of the primary reference.

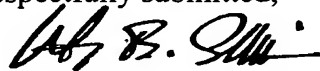
Nord is cited solely to provide further detail of the structure of the materials in *Quillaja Saponaria*. As such, it adds nothing to the disclosures of the above-discussed references.

Accordingly, in conclusion, it is strongly urged that one of ordinary skill in the art would have absolutely no motivation whatsoever to combine the references of record in a manner so as to produce the present invention. Accordingly, withdrawal of the rejection is strongly urged.

The claims of the application are earnestly submitted to be in condition for allowance. However, if the Examiner has any questions or comments, he is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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